

REMARKS

Claims 23-48 are pending in the present application. Claims 23-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blayo et al., U.S. Patent No. 5,739,909 ("Blayo") in view of Abidi et al., U.S. Patent No. 5,539,241 ("Abidi"). Claims 38-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blayo in view of Abidi, and in further view of Curran, U.S. Patent No. 5,126,284 ("Curran"). Claims 43-48 are allowed.

The rejection under 35 U.S.C. § 103(a) with respect to Claims 23-37 should be withdrawn

Claims 23-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blayo in view of Abidi. As the Examiner clearly acknowledges, Blayo fails to teach a coil shaped passive electronic component on a structured surface layer. The Examiner relies on Abidi for teaching a coil-like component and, the Examiner asserts that "it would have been obvious to one of ordinary skill in the art to incorporate a passive electronic component in a shape of a coil in the Blayo semiconductor device, because the coil has a self resonant frequency." (Office Action, page 2).

In response, Applicants have amended claim 23 to explicitly recite an "**etched lateral undercut** of a structured surface on a sacrificial layer," and Applicants respectfully submit that claims 23-37 are allowable for the following reasons. Support for the amended language of claim 23 is found in the original specification, for example, on page 6, lines 9-11.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also provide a motivation or suggestion for combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). Thus, the "problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem." Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

With respect to the coil-like component, Abidi teaches a structure with a reduced parasitic capacitance, not a device for determining the extent of an **etched lateral undercut** of a **structured surface** on a **sacrificial layer**. Moreover, Abidi teaches away from such a device by discussing an etching process in which the silicon substrate is etched and not the sacrificial layer. (See Column 6, lines 1-17). Accordingly, there is no motivation or suggestion in the applied references to combine their teachings to arrive at the invention of claim 23, in order to solve the problem of preventing the destruction of structures when etching in the sacrificial layer.

With respect to the Examiner's assertion that "it would have been obvious to one of ordinary skill in the art to incorporate a passive electronic component in a shape of a coil in the Blayo semiconductor device," the case law and M.P.E.P. § 2143.01 make clear that a statement asserting that combining or modifying the references would have been within the ordinary skill of the art at the time the claimed invention was made does not establish a prima facie case of obviousness without further objective supporting reasons, and that merely stating that "the coil has a self resonant frequency," as asserted by the Examiner, is not a proper objective supporting reason. The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make clear that the Final Office Action's generalized assertions reflect a subjective "obvious to try" standard, and therefore do not constitute proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

It is respectfully submitted that the Final Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Accordingly, it is respectfully submitted that the Final Office Action's assertions in this regard are simply insufficient since the Office has failed to provide proper *evidence* of a motivation or suggestion for modifying the applied references to arrive at the claimed subject matter of claim 23. It is therefore respectfully submitted that claim 23 and its dependent claims 24-37 are allowable, and the rejection of claims 23-37 should

be withdrawn.

The rejection under 35 U.S.C. § 103(a) with respect to Claims 38-42 should be withdrawn

Claims 38-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blayo in view of Abidi and further in view of Curran. Claims 38-42 depend from allowable claim 23. Applicants have explained above that the combination of Blayo and Abidi is insufficient to render obvious the parent claim 23. Furthermore, since Curran fails to remedy the deficiencies of Blayo and Abidi as applied against parent claim 23, the combination of Blayo, Abidi and Curran fails to render obvious dependent claims 38-42.

For the foregoing reasons, Applicants respectfully submit that the rejection of claims 38-42 be withdrawn.

The objection to claim 48 should be withdrawn

It appears that the objection to claim 48 stated on page 6 of the Office Action may be unintended, since claim 48 depends on allowable claim 43 and claim 48 is indicated as allowed on the Office Action Summary sheet. Accordingly, Applicants request confirmation of the allowance or further clarification.

Conclusion

In light of the foregoing, Applicants assert that the present invention is new, non-obvious, and useful. Furthermore, all issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Dated: 1/17, 2003.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend claims 23 as follows:

23. (Twice Amended) A device for determining an extent of an at least locally etched lateral undercut of a structured surface layer on a sacrificial layer, comprising:

at least one passive electronic component arranged on the structured surface layer and in the shape of a coil for determining a physical measured quantity that is proportional to the extent of the etched lateral undercut.